UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,720	09/30/2004	Fred Bishop	60655.3917	5719

66170   7590   07/06/2010
Snell & Wilmer L.L.P. (AMEX)
ONE ARIZONA CENTER
400 E. VAN BUREN STREET
PHOENIX, AZ 85004-2202

EXAMINER
COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
07/06/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM
DMIER@SWLAW.COM
JESLICK@SWLAW.COM

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _07 April 2010_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3,5,6 and 9-14_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1, 3, 5, 6, and 9-14_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This Office action is in reply to Applicants' response filed on 07 April 2010 ("2010 Apr

Response").

2.   Claims 1, 3, 5, 6, and 9-14 are currently pending and have been examined.

3.   This Office Action is given Paper No. 20100618. This Paper No. is for reference

purposes only.

Claim Rejections - 35 USC §103

4.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

5.   Claims 1, 3, 5, 6, 9-11, 13, and 14 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Taylor (U.S. 5,578,808 A), in view of Russell et al. (U.S. 2004/0044627 A1)

("Russell"), and in further view of Fisher (U.S. 2002/0040438 A1).

Regarding Claims 1 and 9

6.   Taylor discloses:

adding, to a first database on a transaction device, a first data set of a first format and a

second data set of a second format (see at least c. 3, ll. 20-40 for discussion on adding multiple

data sets (*e.g.*, applications relating to "AMEX" and "VISA") to smartcard; see also fig. 4),

wherein:

the first data set is owned by a first data set owner and the second data set is

owned by a second data set owner (see at least c. 3, ll. 20-40 for discussion on vendor specific

applications with access code for vendor (*i.e.*, "owner") only),

the first data set owner is distinct from the second data set owner (c. 3, ll. 20-40;

see also fig. 4 for distinct vendors (*i.e.*, "owners")),

the first format is different from the second format (see at least fig. 4), and

the first data set is stored in accordance with the first format, and the second data

set is stored in accordance with the second format (see at least fig. 4);

configuring a first method of authentication corresponding to the first data set and a

second method of authentication corresponding to the second data set (distinct access codes for

each vendor or issuer are configured by respective vendor or issuer; see at least fig. 4),

wherein the first method of authentication and the second method of

authentication are configured by the first data set owner and the second data set owner

independently (each vendor sets access code);

wherein, in response to authentication of the first data set owner using the

respective method of authentication defined by the first data set owner, the first data set owner is

provided access rights to the first data set (see at least c. 3, ll. 20-40 description of vendor access

codes providing access to respective data portion; see also c. 6, ll. 23-28), at least one access

right including authorization to at least one of add and remove a static field of the first format (c.

3, ll. 20-40 – vendor can change data (*i.e.*, add or remove)), and

wherein, in response to authentication of the second data set owner using the respective method of authentication defined by the second data set owner, the second data set owner is provided access rights to the second data set, at least one access right including authorization to at least one of add and remove a static field of the second format (see at least c. 3, ll. 20-40 description of vendor access codes providing access to respective data portion; see also c. 6, ll. 23-28);

providing information relating to the first data set and the second data set for selection (in fig. 7 user selects a data set (*i.e.*, a specific card vendor) from the plurality of available data sets on the smartcard shown in fig. 4, therefore information relating to the plurality of data sets must be "provid[ed]" (*i.e.*, made available) by the smartcard);

receiving a selection of at least one of the first data set and the second data set to complete a transaction request (see at least fig. 7), wherein:

if the first data set is selected, the receiving includes receiving a first secondary identifier indicium corresponding to the first method of authentication (user enters PIN, etc., which corresponds (*i.e.*, has similar form) with vendor access code of first app– see at least fig. 7), and

if the second data set is selected, the receiving includes receiving a second secondary identifier indicium corresponding to the second method of authentication (user enters PIN, etc., which corresponds (*i.e.*, has similar form) with vendor access code of second app – see at least fig. 7);

authenticating, in response to receiving the selection, the transaction request using the

first secondary identifier indicium if the first data set is selected and using the second secondary

identifier indicium if the second data set is selected (see at least fig. 7);

determining, based on the authenticating, whether the transaction request is approved (see

at least fig. 7); and

completing, if the determining indicates that the transaction request is approved, the

transaction request according to the selection (see at least fig. 7).

7.   Taylor does not directly disclose an RF transaction device; and wherein the first method

of authentication and the second method of authentication each include a distinct access

authentication protocol defined by the first data set owner and the second data set owner,

respectively.

8.   Russell teaches an RF transaction device (¶ 0170).

9.   Since each individual element and its function are shown in the prior art, albeit shown in

separate references, the difference between the claimed subject matter and the prior art rests not

on any individual element or function but in the very combination itself – that is in the

substitution of the RF transaction device of Russell for the transaction device of Taylor. Thus,

the simple substitution of one known element for another, producing predictable results, renders

the claim obvious.

10.   Fisher teaches wherein a first method of authentication and a second method of

authentication each include a distinct access authentication protocol defined by a first data set

owner and a second data set owner, respectively (¶¶ 0039 and 0041; and claim 16).

11.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the data set owner authentication of Taylor to include the ability for each data set owner to define a distinct access authentication protocol, as taught by Fisher. One would have been motivated to do so because each data set owner will require assurance that any card data used by their specific data set cannot be read or changed by unapproved means (Fisher, ¶ 0024).

Regarding Claims 3 and 10

12.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as shown above. Taylor, further, discloses wherein at least one of the first secondary identifier indicium and the second secondary identifier indicium is a personal identifier number (PIN) or a biometric identifier (Taylor, fig. 7 with associated text); and wherein the receiving a selection step further comprises receiving an allocation of the entire transaction request to either the first data set or the second data set (Taylor, fig. 7 with associated text).

Regarding Claims 5, 6, and 11

13.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as shown above.

14.   Taylor does not directly disclose:

        wherein the step of receiving a selection further comprises receiving an allocation of a first portion of the transaction request to the first data set for transaction completion, as recited in claim 5; or

wherein the step of receiving a selection further comprises receiving an allocation of a second portion of the transaction request to the second data set for transaction completion, as recited in claim 6; or

wherein the receiving a selection step further comprises receiving a selection of a plurality of data sets to complete the transaction request, as recited in claim 11.

15.   Russell teaches:

wherein a step of receiving a selection further comprises receiving an allocation of a first portion of a transaction request to a first data set for transaction completion (see at least ¶ 0037);

wherein a step of receiving a selection further comprises receiving an allocation of a second portion of the transaction request to a second data set for transaction completion (see at least ¶ 0037); and

wherein a receiving a selection step further comprises receiving a selection of a plurality of data sets to complete a transaction request (see at least ¶ 0037).

16.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the receiving a selection step of Taylor to allow the user to select multiple data sets and to allocate portions of the transaction to the multiple data sets, as taught by Russell, in order to provide the user greater flexibility in funding the transaction.

Regarding Claim 13

17.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as shown above. Taylor, further, discloses wherein the providing information relating to the first

data set and the second data set for selection further comprises providing information during a

transaction (see at least fig. 7).

Regarding Claim 14

18.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as

shown above.

19.   Taylor does not directly disclose wherein the receiving the selection of at least one of the

first data set and the second data set to complete the transaction request further comprises the

selection of a portion of a transaction to allocate to at least one of the first data set and the second

data set.

20.   Russell teaches wherein receiving a selection of at least one of a first data set and a

second data set to complete a transaction request further comprises the selection of a portion of a

transaction to allocate to at least one of the first data set and the second data set (see at least ¶

0037).

21.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the receiving a selection step of Taylor to allow the user to select

a portion of the transaction to allocate to one of the multiple data sets, as taught by Russell, in

order to provide the user greater flexibility in funding the transaction.

22.   Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor, in view

of Russell and Fisher, and in further view of Hoffman (U.S. 2002/0140714 A1).

Regarding Claim 12

23.   The combination of Taylor, Russell, and Fisher discloses the limitations of claim 1, as

shown above.

24.   The combination of Taylor, Russell, and Fisher does not directly disclose wherein the

providing information relating to the first data set and the second data set for selection further

comprises audibly providing information.

25.   Hoffman teaches audibly providing information for selection (see at least ¶¶ 0071 &

0072).

26.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the providing step of Taylor to audibly provide, as taught by

Hoffman, the information relating to the data sets. One would have been motivated to do so

because audibly providing information would allow users with vision related disabilities to use

the invention of Taylor (see Hoffman ¶ 0071).

Claim Interpretation

27.   With respect to claims 1 and 9, the following recitations are not given weight because

they express the intended result of a process step positively recited (see MPEP §2111.04):

> wherein the first method of authentication and the second method of
> authentication are configured by the first data set owner and the second data set owner
> independently;
> wherein, in response to authentication of the first data set owner using the
> respective method of authentication defined by the first data set owner, the first data set
> owner is provided access rights to the first data set, at least one access right including
> authorization to at least one of add and remove a static field of the first format, and
> wherein, in response to authentication of the second data set owner using
> the respective method of authentication defined by the second data set owner, the second
> data set owner is provided access rights to the second data set, at least one access right

including authorization to at least one of add and remove a static field of the second format.

This is an *alternative position*. The Examiner's principle position is that the above "wherein" clauses are either expressly or inherently shown by the references uses in the rejections above.

28.   In addition to the definitions adopted by the Examiner in previous Office actions (see Paper No. 20080711 at p. 12; see also Paper No. 20091230 at p. 6), the Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.[1] Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

agreement "5. the state of being similar or consistent; correspondence; conformity." The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000;

conformity "1. Similarity in form or character; agreement." *Id*.;

correspond "1. To be in agreement, harmony, or conformity." *Id*.;

provide "2. To make available." *Id*.; and

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[1] While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

for "1 a -- used as a function word to indicate purpose... b -- used as a function word to

indicate an intended goal." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc.,

Springfield MA, 1986.

Response to Arguments

Prior Art

29.   Applicants argue:

> Applicant asserts that Russell does not disclose or contemplate selecting a
> funding source. The other cited references do not account for this deficiency. As
> such, the cited references, alone or in combination, do not disclose or contemplate
> at least "[a] method for managing a plurality of data sets on a radio frequency
> (RF) transaction device, the method comprising: adding, to a first database on the
> RF transaction device, a first data set of a first format and a second data set of a
> second format, wherein: the first data set is owned by a first data set owner and
> the second data set is owned by a second data set owner... providing information
> relating to the first data set and the second data set for selection; receiving a
> selection of at least one of the first data set and the second data set to complete a
> transaction request" (emphasis added), as recited in claim 1 and similarly recited
> in claim 9.

See 2010 Apr Response at p. 6 (emphasis in original).

30.   The Examiner respectfully disagrees. Taylor's smartcard device must provide (*i.e.*, make

available; see definition of "provide" above) "information relating to the data sets for selection"

in order for the user to then make a selection of a data set, the selection as described in at least

fig. 7 with associated text.

31.   Applicants are respectfully reminded, 37 C.F.R. §1.111(b) requires Applicants to

distinctly and specifically point out (in writing) the supposed errors of an Office action in

Applicants' reply to the Office action, and also requires that Applicants make a *bona fide* attempt

to advance the application to Final action.

32.   With respect to the §103 rejection given in the previous Office action mailed on 07

January 2010 (rejection repeated above), the Examiner notes that Applicants specifically point

out the supposed errors made by the Examiner (see 2010 Apr Response at pp. 6 & 7).

33.   Because Applicants have addressed the supposed errors of the previous Office action

(mailed on 07 January 2010) in a timely manner by reducing them to writing in the 2010 Apr

Response, the Examiner finds that Applicants are currently compliant with 37 C.F.R. §1.111(b).

If, however, Applicants choose to argue other supposed errors in the future that should have been

argued in the 2010 Apr Response (*e.g.*, supposed errors other than the ones addressed at pp. 6 &

7 of the 2010 Apr Response), the Examiner will find that the 2010 Apr Response is in violation

of 37 C.F.R. §1.111(b) and a *non-bona fide* attempt by Applicants to advance this application to

Final action.

Conclusion

34.   Applicants' amendment filed in the 2010 Apr Response necessitated the new grounds of

rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

35.   Because this application is now final, Applicants are reminded of the USPTO's after final

practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

not a matter of right. "The refusal of an examiner to enter an amendment after final rejection of

claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed.

Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided

by the Examiner are just that—suggestions or examples—and do not constitute a formal

requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

claim is "allowed," exemplary claim language provided by the Examiner to overcome a

particular rejection or to change claim interpretation has *not been addressed* with respect to other

aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written

description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior

art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an

Examiner suggestion or example or simply changes claim interpretation will nevertheless require

further consideration and/or search and a patentability determination as noted above.

36.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

37.   Applicants are respectfully reminded that any suggestions or examples of claim language

provided by the Examiner are just that—suggestions or examples—and do not constitute a

formal requirement mandated by the Examiner. To be especially clear, any suggestion or

example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

      a.   Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, first paragraph.

      b.   Independent of the requirements under 35 U.S.C. §112, first paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP §608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. §132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

38.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure (see attached form PTO-892). All references listed on form PTO-892 are cited in their

entirety.

39.   Any inquiry of a general nature or relating to the status of this application or concerning

this communication or earlier communications from the Examiner should be directed to Jacob C.

Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are

unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

40.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
June 21, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621